

REMARKS**I. Request For Reconsideration And Issue Of An Office Action**

Applicant requested the issuance of a new Action. While the SPE has characterized the request as *sua sponte*, the facts are otherwise and the need therefore is driven solely by the failure of the PTO to act as promised.

Applicant contacted the SPE, held a preliminary telephone conversation with the SPE, and responded to the SPE's request for information, and relied on the SPE's assurance that the SPE would contact the applicant immediately upon a review of the submission so that the interview with the SPE could be conducted prior to the expiration of the shortened statutory period for response to the Final Office Action. The examiner (without the knowledge of the SPE) issued an advisory action. The SPE now asserts that the issuance of that Advisory Action by the examiner obviated any need for further communication with applicant by the SPE, including the fact that the communication the applicant had been promised by the SPE would be not be forthcoming. The SPE did not respond to applicant's several telephone inquiries as previously documented in this file, and as a result of the SPE's failure to schedule an interview or respond to applicant's telephone calls, the applicant is being unfairly charged with a two month extension fee. The issuance of a new Action resetting the time for response to the Final Action is entirely appropriate in this, a user friendly, PTO.

II. Request For A Response to Applicant's Arguments

Applicant has repeatedly requested in writing and at the interview that the examiner set out his position as to the arguments advanced by applicant. To date,

including the Interview Summary, no direct response has been forthcoming to specific questions:

By way of example, I have repeatedly asked in writing and orally that the Office take a definitive position on the law, with citation to the authority relied upon, that:

1. in *haec verba* correspondence between the specification and claims is not required;
2. the law permits the generic claiming of specific articles disclosed in the specification in predictable arts;
3. the combination of references for obviousness requires a motivational teaching; and
4. the law cited by applicant as to the requirements of § 112 is correct.

Further by way of example, I again request that the examiner take a definitive position on the facts as to whether:

1. this is a predictable art;
2. each of the claims is readable on the drawings;
3. there is no express disclosure in any of the cited references of any teaching supporting the combination of references;
4. in the context of this application, the disclosed coated "lead crystal glass\ turtle" is "non- functional"; and
5. the dictionary definitions cited by applicant are correct. (Letter dated 3/18/5).

To the extent not obviated by this amendment and the response of the PTO, applicant renews the request for express answers so that any remaining issues will be defined for purposes of the appeal.

III. The Interview

The courtesy accorded applicant in the interview is acknowledged with appreciation.

In the interview, the examiner for the first time in the prosecution of this application took the position that the language directed to the object being coated (as contrasted with the language directed to the coating) was merely the intended use of the coated article. Applicant pointed out that the claim language "suitable for a [specific use]" is an affirmative limitation on the "substantially transparent substrate," i.e., that there are articles that are suitable as well as articles that are not suitable, and that the language "limits" the articles within the scope of the claim. Any language that limits is a "limitation" rather than an expression of the intended use of the article. It is applicant's understanding that the examiner has conceded the point. Unless the examiner affirmatively states that this position is being adopted, applicant will consider that it has been abandoned.

In the interview, applicant acknowledged that the term "non-functional" does not appear in the written description. There was a great deal of discussion as to the degree of overlap of the terms that do appear, i.e., "decorative objects", "gemstones" and "ornaments", and it was agreed that applicant was entitled to claim these three species of articles of manufacture generically¹. As understood, it was the position of the examiner

¹ If this is not the case, then a detailed explanation of the examiner's position is again solicited.

that the proposed term “non-functional” was not acceptable because “decorative” and ornamentation” were functional². Notwithstanding applicant’s belief that the examiner’s position is in error, applicant proposed the term “ornamental object” as a generic term, and the use of the term was approved by the SPE and examiner as obviating the new matter rejection of the term “non-functional”. It is applicant’s understanding that the SPE and examiner have accepted applicant’s position that the generic “ornamental object” includes, but is not limited to, the three species of ornamental objects disclosed, i.e., “decorative objects”, “gemstones” and “ornaments.”³

The limitations of Claim 22 were specifically discussed with applicant pointing out that one of skill in the art to which this application relates would understand that the disclosed brilliant cut “gemstone” shown in Figure 1 has two dimensions substantially the same, and that the disclosed “turtle” also has two dimensions substantially the same. The Interview Summary is silent as to the position of the examiner, but it is applicant’s understanding that this point has been conceded⁴.

The limitations of Claims 13, 35, 40 and 45 were discussed with applicant pointing out that one of skill in the art to which this application relates would understand that the disclosed “turtle” had at least one curved surface and two dimensions (length and

² Please correct if applicant errs.

³ Please correct applicant’s understanding if not correct.

⁴ If the examiner has not conceded the point, applicant again renews the request that the examiner specifically make his position known as to the identity of the person skilled in the relevant art and his position as to what such person would understand from the disclosure of the application in its entirety.

width of the turtle shell) substantially the same (Claims 13 and 35) and at least one curved surface and the same dimension in two orthogonal directions (length and width of the turtle shell) (Claims 40 and 45). The Interview Summary is silent as to the position of the examiner, but it is applicant's understanding that this point has been conceded⁵.

The limitations of Claim 27 were discussed with applicant pointing out that one of skill in the art to which this application relates would understand that the disclosed "turtle" has two non-parallel curved surfaces. The Interview Summary is silent as to the position of the examiner, but it is applicant's understanding that this point has been conceded⁶.

The limitations of Claims 17 and 28 were discussed with applicant pointing out that one of skill in the art to which this application relates would understand that the disclosed brilliant cut "gemstone" shown in Figure 1 has height, width and length dimensions substantially the same. The Interview Summary is silent as to the position of the examiner, but it is applicant's understanding that this point has been conceded⁷.

The limitations of Claims 44 and 48 were discussed with applicant pointing out that one of skill in the art to which this application relates would understand that the disclosed brilliant cut "gemstone" shown in Figure 1 has height, width and length dimensions substantially the same and a generally circular horizontal cross-section. The

⁵ Ibid.

⁶ Ibid.

⁷ Ibid.

Interview Summary is silent as to the position of the examiner, but it is applicant's understanding that this point has been conceded⁸.

As to the art rejections, applicant argued that there was no factual basis for the combining of the cited references, and the issue was taken under advisement. Applicant now understands that the argument has been found persuasive as to those claims expressly directed to "ornamental objects", and that the art rejection as to all such claims has been withdrawn.

The interview terminated, as it began, with applicant's request that the examiner make his position known as to applicant's arguments and the law cited by applicant so that misunderstandings could be avoided and the appeal directed to the specifically identified issues rather than the mere conclusions of the examiner.

IV. The Section 112 Rejection.

It is applicant's understanding that the new matter rejection of Claim 1 (and Claims 2-12 dependant therefrom) has been obviated by the current amendment of Claim

1. It is further applicant's understanding that the rejection of Claims 13-48 as failing to comply with the written description requirement of Section 112 has been withdrawn. In the event any written description rejection remain, the examiner is again requested to respond to the specific questions earlier posed as to the law and the application of the law to the facts.

⁸ Ibid.

Specifically, does the examiner contend that:

1. in *haec verba* correspondence between the specification and claims is required;
2. the law does not permit the generic claiming of specific articles disclosed in the specification in predictable arts;
3. this is not a predictable art;
4. each of the claims is not readable on the specification; and
5. the law cited by applicant as to the requirements of § 112 is not correct.

In the event that the examiner contends any one or more of the above, a detailed explanation of such position is solicited, including without limitation the factual and legal basis for each such contention.

The examiner's position seems to be that the claim language limiting the substrate for "ornamental objects" is acceptable as a limitation because ornamental objects are disclosed, but that the same claim language limiting the substrate for objects that may, or may not, be ornamental is not acceptable as a limitation because of its breadth. The position of the examiner is not understood. There can be no question that the claim language is a limitation on the substrate, and no question that the language can be read on the substrates of the disclosed species. If the examiner feels that the claims are too broad because they are not limited to objects that are ornamental, then the examiner should cite art, not reject the claims under Section 112.

By way of an example, an applicant disclosing a "jeep" having "rubber tires" is entitled to draft claims that read on such disclosure, e.g.: (1) a "vehicle" ("vehicle" being

generic to the “jeep vehicle” species disclosed) with “rubber tires”, and (2) a “jeep” with “tires” (“tires” being generic to the “rubber tires” species disclosed).

If the examiner contends that the disclosure of a “cubic zirconium substrate” does not support a claim for a “substrate”, he should so state. If the examiner contends that the disclosure of such a “cubic zirconium substrate” with equal height, width and length (Figure 1) dimensions does not support a claim to a “substrate” with equal height, width and length dimensions, he should so state.

It has been repeatedly noted that the examiner has cited no authority whatsoever for such a novel propositions despite the repeated requests of applicant. Applicant has cited law that is clearly to the contrary, and the examiner has not challenged the applicability of the cited law despite repeated requests. Specifically, applicant has cited *Bilstead v. Wakalopulops*, No.13-1528 decided October 7, 2004, where the Federal Circuit reviewed decisions relating to the written description requirement from 1973 to date citing with approval the following as examples of the support of genus claims by the disclosure of a single species in a predictable art:

claim for “an inert fluid” supported by disclosure of “an inert liquid”;

claim for “adheringly applied” supported by disclosure of “applying adhesive”;

and

claim for “protein content of at least about that of solvent extracted soybean meal”

supported by disclosure of “solvent extracted soybean meal with a protein content of about 50%”.

The Federal Circuit stated "disclosure of only identical half-shells was sufficient written description support for a claim encompassing both identical and non-identical half-shells." Should the examiner persist in such a patently untenable position, applicant requests for the third time the citation of the authority on which the examiner relies.

A response that fairly sets out the position of the examiner with respect to this argument is solicited.

V. The Art Rejection.

Claims 17-26, 28 and 40-49 are free of the art. If the Section 112 rejections have in fact been withdrawn, these claims should be allowed.

Claims 1-16, 27 and 29-39 were rejected as obvious over Hettich in view of Austin. As indicated above, applicant now understands that the argument has been found persuasive as to those claims expressly directed to "ornamental objects", and that the art rejection as to all such claims has been withdrawn. Since Claims 1-12 expressly contain such limitation, Claims 1-12 are free of the art and should be allowed, leaving the sole rejection of Claims 13-16, 27 and 29-39 as being obvious over Hettich in view of Austin.

The position of the examiner seems to be that the two cited patents are non-analogous to each other in examining claims directed to ornamental objects, but are analogous to each other in examining claims directed to objects that may be, but need not be, ornamental objects. Applicant submits that the cited art is either analogous or non-analogous to each other without reference to the claims to which the asserted combination is being applied. If the examiner has any authority whatsoever for this novel


position, applicant again requests the citation thereof. If the examiner does not have such authority, the rejections should be withdrawn.

Applicant notes that the examiner has repeatedly failed to respond to applicant's request that the examiner state his position. If the examiner's position is that a motivational teaching is not required for the combination of references for obviousness, please so state. If for example, it is the examiner's position that a teaching is required, applicant again requests that the teaching be specifically identified along with the location thereof in the cited art. Does the examiner dispute applicant's position that it is the examiner that has the burden to show motivation for combining the teachings of the cited patents?

Applicant has substantively discussed the cited art in previous responses. Clearly the examiner in his specious response in the final paragraph of page 4 of the Final Office Action has confused (a) the scope of the teachings of the cited art for the examination of claims and (b) the ability of an applicant to claim generically that which is specifically disclosed. Should the examiner persist in any substantive rejection, applicant again requests that he examiner fairly meet applicant's arguments, specifically disagreeing or agreeing with applicant's statements as to what the cited art fairly discloses.

A further and favorable action and allowance of all claims is solicited.

Respectfully submitted,



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Dated: April 14, 2005